

**REMARKS**

**Amendments to the Claims**

Applicant amended claims 1, 41, 51, and 75 to more clearly recite the structure of the resection electrode. Applicant believes that basis for these amendments may be found in the specification (for example, see the figures and accompanying text). Accordingly, applicant believes that these amendments do not introduce any new matter.

**35 U.S.C. §112**

The Office Action rejected claims 21-24, 26, 27, 35-37, 39, 40, 59, 60, 65, 68-70 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. Applicant amended claims 21, 22, 24, 26, 27, 39, 40, 59, 60, 69, and 84 to address these rejections.

Applicant believes the amendments made herein address this rejection.

**35 U.S.C. §102 - I**

The Office Action rejected claims 1-3, 6, 7, 9, 16-20, 24-27, 32, 34, 37-45, 75-78, and 80-84 under 35 U.S.C. §102(e) as being anticipated by Sharkey et al (6,379,350). Applicant disagrees.

Applicant notes that the Sharkey device teaches electrodes that are configured to provide a mechanical scraping or grating. One skilled in the art will readily appreciate the difference between resection of tissue as compared to grating or scraping. In any event, applicant amended claims 1, 41, and 75 to more clearly recite the structure of the resection electrode. More specifically, the amendments recite the resection electrode (or head) to include a cutting edge that extends away from the resection electrode support. Clearly, the devices taught or suggested by Sharkey fail to teach this structural limitation. Accordingly, Sharkey fails to anticipate claims 1, 41, and 75 and all claims ultimately depending therefrom.

In view of the amendments herein, applicant requests withdrawal of this rejection.

35 U.S.C. §102 - II

The Office Action rejected claims 41 and 43-48 under 35 U.S.C. §102(e) as being anticipated by Underwood et al (6,283,961.) Applicant disagrees. In view of the amendment to claim 41, Underwood fails to anticipate claim 41 and all claims ultimately dependent therefrom.

Applicant respectfully requests withdrawal of this rejection.

35 U.S.C. §103 - I

The Office Action rejected claims 8, 10-14, 23, and 48 under 35 U.S.C. §103(a) as being unpatentable over Sharkey et al. (6,379,350.) The Office Action stated that particular structural features of the wire and the particular voltage limitations would have been obvious design expedients to the skilled artisan. Applicant disagrees. As discussed above, the Sharkey reference teaches scraping or grating tissue. In contrast, applicant's device is structurally adapted to resect tissue. In any case, in view of the amendments made to the claims, applicant believes this rejection is moot.

Applicant requests withdrawal of this rejection.

35 U.S.C. §103 - II

The Office Action rejected claims 15, 51-60, 62-65, 68-70, and 85 under 35 U.S.C. §103(a) as being unpatentable over Sharkey et al. (6,379,350) in view of Baker (5,785,705.) Applicant disagrees.

As discussed above, applicant amended claim 1, 51, and 75 from which the rejected claims ultimately depend. The addition of Baker to Sharkey does nothing to overcome the deficiencies of Sharkey.

In view of the above, applicant respectfully requests withdrawal of this rejection.

Allowable Subject Matter

Applicant's attorney wishes to express gratitude to the Examiner for the indication that claims 21, 33, 35, 36, 61, and 79 would be allowable if amended as recited in the Office Action.

Although applicant amended the claims, applicant reserves the right to re-introduce the above claims in independent form prior to the amendments made herein.

SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Sanjay S. Bagade', with a stylized flourish at the end.

Sanjay S. Bagade  
Reg. No. 42,280

ArthroCare Corporation  
680 Vaqueros Ave.  
Sunnyvale, CA 94085-3523  
(408) 736-0224